

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

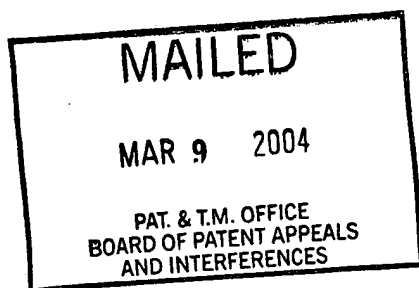
Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAN ERIKSSON

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Appeal No. 2004-0696  
Application 09/581,911

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ON BRIEF

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Before ABRAMS, FRANKFORT and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner under the authority provided us by 37 CFR § 1.196(a) and the

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Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev 1, Feb. 2003) for action in accordance with the following comments.

The above-identified application is being REMANDED to the examiner for appropriate consideration of appellant's reply brief (Paper No. 20) filed on December 8, 2003 in response to the examiner's answer mailed October 7, 2003 (Paper No. 18). As noted in 37 CFR § 1.193, the examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. We note in passing, that appellant has argued in the reply brief (page 2) that the examiner has attempted to "substitute a new rejection for the rejection of record" and that the examiner has relied upon new disclosure in Jakobson to support that new position. If true, this would appear to be contrary to the proscription in 37 CFR § 1.193 (a)(2) which states

that an examiner's answer "must not include a new ground of rejection."

In addition to the foregoing, we note that the examiner's answer (pages 2-3) appears to indicate that the applied references are intended to be Jakobson et al. (U.S. 4,508,058), Finger (EP 0244642) and Innings (WO 96/36212). The examiner's answer further includes, on page 3, a statement regarding the grounds of rejection applicable to the appealed claims. In that statement, the examiner indicates

Claims 1-10 rejected under 35 U.S.C. 103(a).  
This rejection is set forth in prior Office  
Action, Paper No. 10.

Our problem is that Paper No. 10, mailed February 13, 2002, includes rejections under both 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) on references other than those listed on pages 2-3 of the answer. However, we observe that other portions of the examiner's answer would appear to indicate that it is

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the rejections as set forth in Paper No. 15, mailed February 13, 2003, the examiner intends to maintain. On remand, the examiner should clearly set forth which rejections are to be reviewed on appeal.

If we assume that it is the rejections as set forth in Paper No. 15 which are to be reviewed on appeal, then we have an additional problem. In Paper No. 15, Claims 1-4 and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jakobson in view of Finger, while claims 5-7 (which depend from claim 1) stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jakobson "as applied to claim 1 above" and further in view of Innings. The examiner has not explained why Finger, apparently needed for maintaining a rejection of independent claim 1, has not been applied in the rejection of dependent claims 5-7. On remand, this inconsistency should be addressed.

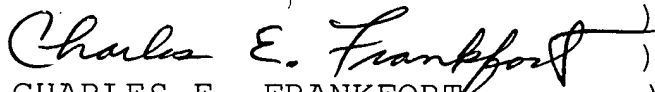
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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (8th ed., Rev. 1, Feb. 2003). Further, it is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

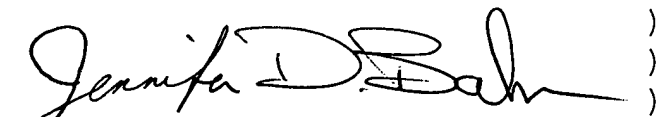


NEAL E. ABRAMS )  
Administrative Patent Judge )



CHARLES E. FRANKFORT )  
Administrative Patent Judge )

BOARD OF PATENT  
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